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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,078	07/05/2005	Harald Weigelt	STERN22.001APC	6848
20995 7590 08/20/2009 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER LEE, LAURA MICHELLE				
ART UNIT 3724		PAPER NUMBER		
NOTIFICATION DATE 08/20/2009		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/522,078

Applicant(s)

WEIGELT, HARALD

Examiner

LAURA M. LEE

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 11-12, 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 1/19/2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/2009 has been entered. Claims 1-22 are pending, claims 1 and 3 are currently amended, claims 6, 10, 13, are withdrawn and claims 20-22 are new

Drawings

2. The objection to the drawings in the 1/22/2009 office action is rescinded.
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of a stripping element with a non-circular cross-section, a guide element with a substantially similar cross-section (claim 1) and at least one guide bushing within the stripping element (claim 16) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claims 7, 9, 18, and 21 is objected to because of the following informalities:

Claim 7, line 2, there is a lack of proper antecedent basis for "the length" and should be -- a length--.

Claim 7, line 3, "can be selected" is suggested to be changed to --can be provided-- or --is determined--.

Claim 9, line 2, "a fitted cutting element" should be --the fitted cutting element--.

Claim 18, lines 1-2, "wherein the guide surface" should be changed to --wherein the at least one guide surface-- to keep proper antecedent basis with claim 9.

Claim 21, line 2, "current element" should be --cutting element--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 16, recites the further limitation that "the guide element comprises at least one guide bushing arranged within the stripping element and configured to guide the stripping element" as is shown in the embodiment of Figures 9-11. However, claim 1, from which claim 16 depends, previously recited that the stripping element has a non-circular cross section, of which the guide element has a hole or opening with a cross-section substantially similar to the cross section of the stripping element. This structure is evident from the embodiments of Figures 2-8. However, the Figures of 9-11 do not show that the stripping element has a non-circular cross-section of which the guide element has a hole or opening with substantially similar cross-section, and instead portray a circular cross-section. Also the specification discloses that the embodiment of Figures 9-11 is prevented from rotation by the

shoulder screws 36. There is no suggestion from the specification or drawings that the applicant had possession of this claimed combination of a guide element comprising least one guide bushing arranged within a non-circular stripping element at the time of the applicant's filing.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-5, 7, 9, 11, 12, 14-15, and 17- 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Wales (U.S. Patent 2,168,377). Wales discloses a stripping device (Figure 5) for use with a cutting tool (ram, 21 and punching unit 34-36,) with a cutting element (punch tip 36/ square bit 65) for machining a workpiece (punch a hole), the stripping device comprising: at least one fastening piece (i.e. screw 60) for fastening the stripping device to the cutting tool; a spring elastic element (spring 41) arranged outside of the workpiece contact region; a stripping element (stripper 65, Figure 7) which comes into contact with the workpiece (i.e. see Figure 2) and surrounds the cutting element (punch tip 36/65), wherein the stripping element has a non-circular cross-section (see Figure 7, wherein the stripper 65, has an elongated slot 174 such that cross-section is not a complete circle); and at least one guide element (punch holder, 94), where the guide element comprises a hole or opening (not numbered, see

Figures 7 and 10) with a cross-section substantially similar to the cross-section of the stripping element (see Figure 10, wherein the punch holder 94 and the stripper 65 are aligned except for the slot 174), wherein the stripping element is essentially prevented from rotating (by the set screw 73, which engages the slot 174 in the stripper 65).

In regards to claim 3, Wales discloses wherein the hole (between the stripper 65 and the punch holder 94) has an elongated or polygonal shape (is an elongated substantially cylindrical hole).

In regards to claim 4, Wales discloses wherein the stripping element (65) has a cross-sectional shape with three straight sides (surrounding the slot 174; see Figure 10) and one curved side (extending from the slot 174).

In regards to claim 5, Wales discloses wherein the guide element (punch holder 94) comprises at least one guide sleeve (cylindrical portion of 94) arranged outside the stripping element (65), at least partially surrounding the stripping element in a guiding manner.

In regards to claim 7, Wales discloses at least one guide surface (on of the circumferential surface of stripping element / mating surface of guide element and/or the slot 174 engaged with pin 73) between the stripping element (65) and the guide element (94) with a length which provides for tilt free guidance in the same structural relationship as shown by applicant. As applicant has provided no additional structural relationship to meet the limitations of tilt-free guidance, it is considered that Wales anticipates this claim. The limitations of "can be selected as a function of the forces acting on the stripping device" do not impart any structural component to the length and are also a conditional

phrase, which are not positively recited. Also, it is considered that the pin, 73, at least engaged with the slot 174 would prevent tilt of the stripper element, if not also considering the relative length of engagement between the stripping element and guide surface.

In regards to claim 9, Wales discloses wherein the stripping element (65) has at least one guide surface (square circumference; Figure 10) on its inside facing the fitted cutting element (66) and the stripping element (65) and the spring elastic element (41) are orientated, surrounding the cutting element (66), in such a manner that they can be loaded in a manner essentially free from torque. The stripping element and spring are loaded linearly without twisting such as would be in a torque inducing threading action.

In regards to claim 11, Wales discloses wherein the fastening piece (60) and the guide element (94) are formed as elements which can be joined together (see Figure 5).

In regards to claim 12, Wales discloses wherein the spring elastic element (41) is arranged between the guide element (94) and the cutting tool (66) within the guide element (94).

In regards to claim 14, Wales discloses wherein the stripping element (65) has a front surface (bottom facing surface) corresponding to (engages) the workpiece.

In regards to claim 15, Wales discloses that the spring elastic element (stripper/ejector spring 41) is of a spring-elastic, restoring or flexible material. Although Wales does not specifically state what material the spring is made of, inherently a spring is made of an elastic or flexible material, or it wouldn't be a spring.

In regards to claim 17, the type of forces have no bearing on the structure claimed and do not distinguish over the structure of the prior art and the guide surface length is capable of being replaced with another guide of varying lengths according to a variety of motivating factors including shearing and lateral forces.

In regards to claim 18, Wales discloses wherein the guide surface (square circumference of 65 ; Figure 10)) faces a stem (66) of the fitted cutting element.

In regards to claim 19, Wales does not positively disclose the material of the front surface of the stripping element, however, as claim 19 leaves the actual material open to selection, no particular material is being positively claimed. It is shown from at least the drawings that the bottom or front surface of the stripping element is flat and engages with the flat surface of the workpiece. Therefore, Wales anticipates the language of the claim where the front surface is matched to a shape of the workpiece surface. The limitation that the material is machined is a broad product by process limitation, where not only could several manufacturing options be considered as machining processes, but that these processes do not define over the structure of the prior art. Even though the product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

In regards to claim 20, Wales discloses wherein the at least one fastening piece (screw, 60) is for detachably fastening the stripping device to the cutting tool.

In regards to claim 21, Wales discloses wherein the spring elastic element (41) surrounds the cutting element (66).

In regards to claim 22, Wales discloses wherein the guide element (94) has a continuous inner surface defining the hole (see Figures 5 and 7).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wales (U.S. Patent 2,168,377) in view of Taylor (U.S. Patent 2,760,574). Wales discloses the claimed invention except where the stripping element has a cross-sectional shape with no rotational symmetry. Attention is further directed to the Taylor cutting tool and stripping device. Taylor discloses, like Wales, the use of a set screw (pin, 30) and a vertical slot (31) prevent the stripper (26) from rotating in the hole (25) formed by the guide element. However, Taylor also discloses providing the stripper with a shape that prohibits turning of the stripper in the hole, especially during reciprocating movements of the stripper (see col. 3, lines 4-19). Therefore, Taylor discloses an additional means to prevent the stripper from rotating as was already previously established by Wales. It

would have been obvious to one having ordinary skill in the art to have similarly incorporated a stripping element with a cross-sectional shape with no rotational symmetry in the Wales device in addition to the already provided set-screw as taught by Taylor as an additional well known means to prevent the rotating of the Wales stripping element and as a beneficial guiding means during reciprocating movement of the stripping element.

11. Claims 1, 7-8, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wales (U.S. Patent 2,168,377) in view of Taylor (U.S. Patent 2,760,574). Wales discloses a stripping device (Figure 1) for use with a cutting tool (ram, 21 and punching unit 34-36,) with a cutting element (punch tip 36/ square bit 65) for machining a workpiece (punch a hole), the stripping device comprising: at least one fastening piece (i.e. screw 37) for fastening the stripping device to the cutting tool; a spring elastic element (spring 41) arranged outside of the workpiece contact region; a stripping element (punch guide/stripper 40,) which comes into contact with the workpiece (i.e. see Figure 2) and surrounds the cutting element (punch tip 36), and at least one guide element (punch holder, 19), where the guide element comprises a hole or opening (not numbered containing the stripper 40) with a cross-section substantially similar to the cross-section of the stripping element. Wales does not disclose wherein the stripping element has a non-circular cross-section such that the stripping element is essentially prevented from rotating. However, attention is further directed to the Taylor cutting tool and stripping device. Taylor discloses, the use of a set screw (pin, 30) and a vertical

slot (31) prevent the stripper (26) from rotating in the hole (25) formed by the guide element or alternatively providing the stripper with a shape that prohibits turning of the stripper in the hole, especially during reciprocating movements of the stripper (see col. 3, lines 4-19). Taylor discloses that the prevention is rotation of the stripper benefits the punching stroke in eliminating binding in the tool and assures that parts are accurately aligned and oriented with respect to cooperating parts, especially if the punch is to be substituted for one with a noncylindrical cross-section. It would have been obvious to one having ordinary skill in the art to have similarly incorporated a non-circular stripping element in the Wales device as taught by Taylor as an additional well known means to prevent the rotating of the Wales stripping element thereby preventing any resulting tool binding and assuring proper tool alignment between cooperating parts.

In regards to claim 7, the modified device of Wales discloses at least one guide surface (the noncircular mating surface) between the stripping element (40) and the guide element (19) with a length which provides for tilt free guidance in the same structural relationship as shown by applicant. As applicant has provided no additional structural relationship to meet the limitations of tilt-free guidance, it is considered that Wales anticipates this claim. The limitations of "can be selected as a function of the forces acting on the stripping device" do not impart any structural component to the length and are also a conditional phrase, which are not positively recited

In regards to claim 8, the modified device of Wales discloses wherein the stripping element has an essentially straight (around the tip 36) and protruding section (42), and wherein the stripping device comprises guide surfaces on the straight and

protruding sections of the stripping element (the outer surface of the stripping element and inner surface of the guide correspond to allow relative movement between the two).

In regards to claim 17, the type of forces have no bearing on the structure claimed and do not distinguish over the structure of the prior art and the guide surface length is capable of being replaced with another guide of varying lengths according to a variety of motivating factors including shearing and lateral forces.

Response to Arguments

12. Applicant's arguments with respect to claims 1-5, 7-9, 11-12, 14-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAURA M. LEE whose telephone number is (571)272-8339. The examiner can normally be reached on Monday through Friday, 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura M Lee/
Examiner, Art Unit 3724
8/16/2009